

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: March 24, 2009

Signature: 

(Marshall P. Byrd)

Docket No.: 30986/40924
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Martin A. Crockard et al.

Application No.: 10/570,588

Confirmation No.: 7390

Filed: September 2, 2004 as International (PCT)
Application No. PCT/GB04/03773

Art Unit: 1645

For: Diagnosis of Risk of Breast Cancer

Examiner: Not Yet Assigned

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON
FAILURE TO RECEIVE OFFICE ACTION (NOTIFICATION OF DEFECTIVE
RESPONSE) PURSUANT TO MPEP § 711.03(c)(I) and 37 CFR § 1.181**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madame:

Pursuant to 37 C.F.R. § 1.181, the Applicants, through their undersigned representative, hereby petition to withdraw the holding of abandonment in the above-referenced application without penalty to the Applicants.

This petition is submitted in response to the receipt of a Notice of Abandonment mailed March 10, 2009 by the U.S. Patent and Trademark Office (PTO), and received by Applicants on March 16, 2009. The Notice of Abandonment indicates that this case has gone abandoned for failure to respond to the Notification of Missing Requirements (mailed on November 22, 2006). Applicants, however, timely responded to the Notification of Missing Requirements on January 19, 2007, and received no further correspondence from the PTO in this matter until receipt of the Notice of Abandonment on March 16, 2009.

After receipt of the Notice of Abandonment, the undersigned law firm reviewed its file to verify that a response to the Notice was filed, and further reviewed the PTO's electronic file wrapper on the PTO's PAIR website. The review of PAIR revealed a "Notification of Defective Response" which was allegedly mailed on August 24, 2007 (mail date specified on Notification). Applicants, however, never received the Notification of Defective Response, and this Notification is not mentioned in the Notice of Abandonment. In view of Applicants' *bona fide* response to the Notification of Missing Requirements and failure to receive any Notification of Defective Response, Applicants request that the holding of abandonment be withdrawn.

The undersigned agent hereby states and attests as follows:

1. The PTO mailed a Notification of Missing Requirements (Exhibit A) in the above-identified application to the Applicants on November 22, 2006 (received by Applicants on December 7, 2006). The Notification of Missing Requirements indicated that the following items needed to be supplied to the PTO within a two month, extendable period for response:

- a. An oath or declaration signed by all inventors;
- b. A surcharge under 37 C.F.R. §1.492(h) for \$130;
- c. A statement that the contents of the sequence listing recorded in computer-readable form is identical to the written sequence; and
- d. A copy of the sequence listing in computer-readable form.

2. Applicants timely responded to Notification of Missing Requirements on January 19, 2007, by U.S. First Class Mail. The response included:

- a. An oath or declaration signed by all inventors;
- b. A surcharge under 37 C.F.R. §1.492(h) for \$130;
- c. A statement that the contents of the sequence listing recorded in computer-readable form is identical to the written sequence;
- d. A copy of the sequence listing in computer-readable form;

- e. An information disclosure statement, SB08 form and references;
- f. A response to the Notification of Missing Requirements; and
- g. A copy of the Notification of Missing Requirements.

3. The response to the Notification of Missing Requirements was stamped as received by the PTO on January 22, 2007. A copy of the response documents, not including references cited in the Information Disclosure Statement is enclosed herewith as Exhibit B.

4. The PTO allegedly mailed a Notification of Defective Response in the above-identified application to the Applicants on August 24, 2007. The Notice alleged that the computer-readable form of the sequence listing supplied by Applicants failed to comply with 37 C.F.R. 1.822 and/or 1.823 in that no file was contained on the computer-readable media supplied by Applicants (Exhibit C). A non-extendable one-month date to reply to the Notification of Defective Response was apparently set by the Office for September 24, 2007.

5. The undersigned hereby states that the Notification of Defective Response was not received by the undersigned or the undersigned's firm, Marshall, Gerstein & Borun LLP. A search of the file corresponding to this application and docketing records indicates that the Notification of Defective Response was not received.

6. It is the standard practice of Marshall, Gerstein & Borun LLP to record all Notifications of Defective Responses and other Office Actions on the file jacket of the file corresponding to an application when such Notices or Actions are received. A copy of the file jacket for this application is attached hereto as Exhibit D. If the Notification of Defective Response had been received, an indication of the Notification of Defective Response, its mailing date, and the one-month due date would have been recorded on the file jacket in the left-hand column, as was done for the original Notification of Missing Requirements. The absence of any notations concerning the Notification of Defective Response demonstrates that the Notice was never received.

7. It is another standard practice of Marshall, Gerstein & Borun LLP to record all Notifications of Defective Response and other Office Actions from the PTO in an electronic docketing system as soon as they are received. A copy of the electronic docket report for this application is attached hereto as Exhibit E. The electronic docket report has no entry with respect to the Notification of Defective Response, which indicates that it was not received by

Marshall, Gerstein & Borun LLP. If the Notification of Defective Response had been received, a one-month response due date of September 24, 2008 would have been recorded in the “Docket Dt.” and “Due Date” columns on the second page of the docket report with a code of “RESP” in the “Action” column.

8. It is another standard practice of Marshall, Gerstein & Borun LLP to record all Notifications of Defective Response and other Office Actions received from the PTO on a handwritten log on a daily basis. A copy of a portion of the handwritten log used by the docketing department of Marshall, Gerstein & Borun LLP is attached hereto as Exhibit F. All Notifications of Defective Response and other Office Actions received each day by Marshall, Gerstein & Borun LLP, are entered into the log by the attorney docket numbers, the Patent Application Numbers, codes indicating the types of actions, and the due dates for replying to the actions. Exhibit F includes a copy of the handwritten log of Marshall, Gerstein & Borun LLP from August 22, 2007 to October 24, 2007. If the Notification of Defective Response had been received by Marshall, Gerstein & Borun LLP between these dates, it would have been recorded on one of the pages in Exhibit D with a code “RESP” and the one-month date of September 24, 2007, under attorney docket number 30986/40924. There is no entry for the Notification of Defective Response.

9. To the best of my knowledge, Marshall, Gerstein & Borun LLP first became aware of the Notification of Defective Response when investigating the Notice of Abandonment during the week of March 16, 2009, when the file wrapper for the case was reviewed on PAIR.

Applicants submit that the guidelines for granting a “Petition to Withdraw Holding of Abandonment” outlined in chapter 711.03(c)(I)(A) of the Manual of Patent Examining Procedure have been satisfied. In accordance with 37 C.F.R. § 1.181(f), this paper is timely filed, as it is being submitted within two months of the discovery of abandonment (i.e., within two months from the receipt of the Notice of Abandonment received on March 16, 2009). No petition fee is required. In view of the foregoing, withdrawal of abandonment and acknowledgement of the active status of this application.

Pursuant to the Notification of Defective Response, enclosed herewith is a response to the Notification of Defective Response including a copy of the sequence listing in computer-

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Petition dated March 24, 2009

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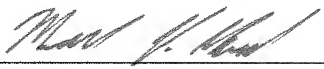
readable form (a .txt file) and a statement that the content of the sequence listing supplied in computer-readable form is identical to the paper sequence filed on January 19, 2007.

Although Applicants believe that no fees are due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith, including the issue fee in this case, to our Deposit Account No. 13-2855, under Order No. 30986/40924.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call David Gass or the undersigned agent at the number listed below.

Dated: March 24, 2009

Respectfully submitted,

By 

Marshall P. Byrd

Registration No.: 62,454

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